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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: BATES ET AL.

Application: METHOD AND COMPUTER PROGRAM PRODUCT FOR IDENTIFYING
HYPERTEXT LINKS IN DOCUMENT PRINTOUTS

Serial No.: 09/292,444

Filing Date: April 15, 1999

Art Unit: 2176

Examiner: Rachna Singh

Case: RO998-222

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APPLICANTS' REPLY TO EXAMINER'S ANSWER

Sir:

In response to the Examiner's Answer mailed January 11, 2006,

Applicants reply to the argument raised by the Examiner as follows. For the reasons set forth in the Appeal Brief and below, it is submitted that the Board should reverse the final rejection of claims 1-10, 12-14 and 16-17.

Applicants respectfully submit that there are significant differences between what is disclosed in the Stork et al. patent and the subject matter of the pending claims so that it is inappropriate for the Examiner to have rejected claims 1-3, 6, 10, 12-14 and 16-17 of the above-identified application under 35 U.S.C. §102 because it is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986).

In the Grounds of Rejection, at pages 3-7, for example, in Examiner's analysis of claims 1-3, 6, 10, 12-14, 16 and 17, the Examiner incorrectly indicates certain claimed subject matter is present in the prior art. The scope and content of the prior art is believed to be accurately described at pages 11-13 of Applicants' Brief on appeal.

Claims should be given their broadest reasonable interpretation consistent with the specification. The claim language itself governs its meaning. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). The meaning of claim language is construed according to its usage and context. ResQNet.com, Inc. v. Lansa, Inc., 346 F.3d 1374, 1378 (Fed. Cir. 2003). The touchstone for discerning the usage of claim language is the understanding of those terms among artisans of ordinary skill in the relevant art at the time of invention. See Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed. Cir. 2001). Indeed, normal rules of usage create a "heavy presumption" that claim terms carry their accustomed meaning in the relevant community at the relevant time. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359,

1366 (Fed. Cir. 2002) (citing Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed. Cir. 1999)). The best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention. In addition to providing contemporaneous technological context for defining claim terms, the patent applicant may also define a claim term in the specification "in a manner inconsistent with its ordinary meaning." Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1347 (Fed. Cir. 2003) (citing Teleflex, 299 F.3d at 1325-26). Dictionaries, encyclopedias and treatises are particularly useful resources to assist in determining the ordinary and customary meanings of claim terms. Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed. Cir. 2002).

Applicants respectfully submits that the Examiner incorrectly indicates that Stork teaches certain claim limitations. For example, at page 9, the Examiner points to column 8, lines 30-37 of Stork et al. and states: Compare to "**sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.**"

Applicants at page 14 of the Appeal Brief quoted column 8, lines 30-37 of Stork et al., where it is stated:

The present invention includes a process by which a hypertext document is converted into a plain paper document. One embodiment of this process is shown in FIG. 5. The hardcopy document that results contains hypertext link information in machine readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into a

hypertext document.

Applicants respectfully submit that it is clear that this above quoted column 8, lines 30-37 of Stork et al. does not teach, suggest, nor provide any motivation for rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link, when the claim term is construed in a manner consistent with the ordinary and customary meaning of the claim term and as taught by Applicants the patent specification where the invention is described.

Only Applicants teach rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link, and printing a corresponding uniform resource locator (URL) for each external hypertext link. Anticipation requires that the reference contain all of the elements of the claims and requires that the elements are arranged in the same way to achieve the same result which is asserted to be an inventive function. This claimed limitation as taught and claimed by Applicants requires printing a corresponding uniform resource locator (URL) for each external hypertext link. The machine readable encoded information provided by Stork et al. in a document printout is not equivalent to, nor does not achieve, nor suggest the step of printing a corresponding uniform resource locator (URL) for each external hypertext link.

Applicants respectfully submit that the Examiner's reliance on Stork et al. as set forth above and in the Appeal Brief, fails to provide any showing of why or how

Stork is equivalent to the claimed limitation and it is unclear what teaching or disclosure of Stork suggests the claimed limitation. Applicants respectfully submit that Stork clearly does not meet the claimed step of printing a corresponding uniform resource locator (URL) for each external hypertext link.

To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way. Since this machine readable encoded information provided by Stork et al. in a document printout is not equivalent to, nor does not achieve, nor suggest the step of printing a corresponding uniform resource locator (URL) for each external hypertext link, the rejection under section 102 should be reversed.

Web documents, such as taught by Stork et al., are designed for browsing or reading on line. The linked information printed on a WEB document printout generated according to the teachings of Stork et al. fails to enable a user to identify the linked information from the document printout. When reading a web based document on line, a user uses a mouse to click on the hypertext links or references to see the linked information. From a document printout generated according to the teachings of Stork et al., the user cannot view the document printout and identify a **corresponding uniform resource locator (URL) for each external hypertext link**.

In the present invention Applicants enable a user to identify hypertext links in document printouts. As taught and claimed by Applicants, **printing a corresponding uniform resource locator (URL) for each external hypertext link** enables a user to view a document printout and identify the hypertext link.

Applicants respectfully submit that the encoded machine-readable information located anywhere on the document printout where human-readable information is not obscured as taught by Stork et al., does not achieve, expressly or under principles of inherency, the claimed **printing a corresponding uniform resource locator (URL) for each external hypertext link** in the recited method for identifying hypertext links in document printouts of the invention.

Applicants respectfully submit that Stork et al. fails to disclose, expressly or under principles of inherency, the claimed invention as recited by the separately patentable claims 1, 3, 4, 10, 13, and 17.

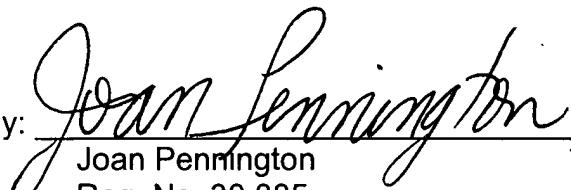
CONCLUSION

Applicants respectfully submits that the prior art provides no teaching, suggestion or inference to achieve the claimed invention as recited by the separately patentable claims 1, 3, 4, 10, 13, and 17.

For the reasons set forth here and in Applicant's Brief on appeal, it is submitted that claims 1-10, 12-14 and 16-17 are patentable and the final rejection of claims 1-10, 12-14 and 16-17 should be reversed.

Respectfully submitted,

By:


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